

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. EVANS,
JAMES W. FINKOWSKI and GENE A. RUSSEL

MAILED
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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-2009
Application 09/241,508

ON BRIEF

Before PAK, WARREN and OWENS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain any of the grounds of rejection advanced on appeal: claims 71 through 74 stand rejected under 35 U.S.C. § 102(b) as anticipated by Makowecki; claims 60 through 64, 68 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makowecki; claim 70 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makowecki as applied above, in view of Rademaker B.V.; and claims 65 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makowecki as applied

above, in view of Simelunas.^{1,2}

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in the reference, either expressly or under the principles of inherency. *See generally, In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). It is further well settled that in order to establish a *prima facie* case of obviousness under § 103(a), the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims arranged as required by the claims, without recourse to the teachings in appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The two central embodiments disclosed in the written description of the specification are described at pages 4-7 and FIGs. 3, 4, 5, 6A and 6B. According to the specification, the cutting portion 18 of cutter 16 of FIGs. 3, 4 and 5 is blunt and thus will, without more, "sever," that is, "[t]o cut or break forcibly into two or more parts,"³ the dough sheet into portions. This blunt part of the cutter is modified in FIGs. 6A and 6B and shown in cutter 31 as cutting portion 34 which now includes cutting edge 32, the cutting edge 32 being generally disposed around the outer

¹ See the appendix to the brief for appealed claims 60 through 66 and 68 through 74. Claims 75 through 77 are also of record and have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b). The examiner points out that appellants have not cancelled these claims in the communications of August 23, 2002 (Paper No. 22) and of April 28, 2003 (Paper No. 28).

² Answer, pages 4-7.

³ This is the ordinary dictionary meaning of "sever" in context. *See, e.g., The American Heritage Dictionary, Second College Edition* 1123 (Boston, Houghton Mifflin Company, 1982)

periphery of cutter 31 and protrudes below dough engaging portion 34, the dough engaging portion 34 forming the inner periphery of cutter 31. This arrangement functions as follows:

Cutting edge 32 can be a *flat edge*, or it can be *sharpened or tapered*. Therefore, *cutting edge 32 actually severs dough sheet 15, while dough engaging portion 34, which is relieved from the cutting edge 32, provides a blunt dough engaging surface* which is sufficiently thick to frictionally engage, and pull, the top surface 26 of dough sheet 15 toward the bottom surface 28 thereof, and to seal the two together (or pinch them together with possibly only a small gap between the two caused by edge 32), in order to provide the eventual rounded dough product. *Since cutting edge 32 is provided, the cutting pressure required to cut through, or sever, dough sheet 15 has been observed to be less than that required for a cutter (such as cutter 16 illustrated in the previous figures) which has no such cutting edge.* [Page 7, lines 12-26; emphasis supplied.]

It follows from this description that the cutter embodiment encompassed by FIGS. 3, 4 and 5 function differently in severing the dough sheet into portions than does the cutter embodiment encompassed by FIGS. 6A and 6B.

We have attempted to interpret appealed claims 60 through 66 and 68 through 70 by reading the written description in the specification and figures on the claim language, and find that we cannot arrive at a reasonable interpretation in doing so. Indeed, while appellants explain appealed claim 60 in light of specification FIG. 6A in the brief (page 7), it appears that this claim requires a cutter having “a blunt dough engaging portion . . . that extends sufficiently to sever the dough sheet” and “a surface portion that is not perpendicular to the direction of extension of the blunt dough engaging portion” which would appear to include only the cutter embodiment encompassed by FIGS. 3, 4 and 5 and exclude the cutting edge 32 of FIGS. 6A and 6B.

However, it would appear from the specification that the “flat tip” of appealed claim 62 and the “angled surface” of appealed 63 would encompass cutting edge 32, and certainly appealed claims 68 through 70 require “a cutting edge” which is cutting edge 32, all of FIGS. 6A and 6B. The difficulty presented by this record presents is that it thus appears that appellants consider appealed claim 60 to encompass both embodiments in view of their arguments and because appealed claims 62, 63 and 68 through 70 are dependent thereon, and the claim language does not permit such construction even if the last clause of claim 60 would including cutting edge 32.

specification as it would be interpreted by one of ordinary skill in the art, these claims in fact fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity as required by 35 U.S.C. § 112, second paragraph. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Because we cannot make a reasonable, conditional interpretation of these appealed claims based on the specification that is adequate for purposes of resolving prior art issues without unsupported speculative assumptions, these claims are thus so indefinite that prior art may not be applied thereto without speculation. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962); cf. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993); *Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984). On this basis, we reverse the three grounds of rejection covering these appealed claims under 35 U.S.C. § 103(a).

We can interpret appealed claims 71 through 74 in light of the written description, including the drawings, of the specification to encompass the embodiments of FIGs. 3, 4 and 5 in claims 71 and 72, and the embodiments of FIGs. 6A and 6B in claims 73 and 74. All of these claims specify a method of cutting a dough sheet while the method of Makowecki, as appellants point out, cuts an extruded cylindrical “tube” which consists of a filling complete surrounded by a coating of dough. Thus, on its face, Makowecki does not disclose all of the elements of the claimed method arranged as required by claims 71 through 74 which is necessary to support a rejection for anticipation under § 102(b). Indeed, the examiner’s contention that “[t]he method of Makowecki provides the same function as appellants’ method” (answer, page 7) is a concept related to obviousness under § 103(a). Furthermore, with respect to appealed claims 71 and 72 which require that the blunt edge cutter sever the dough sheet, as appellants contend, the examiner’s statement that “the Office has not relied upon the sealing lips to teach severing the dough” (answer, page 8) is an admission that the reference does not teach this limitation of appealed claims 71 and 72. Accordingly, we reverse the ground of rejection of appealed claims 71 through 74 under 35 U.S.C. § 102(b).

We remand this application to the examiner to consider the issues that we have raised above with respect to the compliance of appealed claims 60 through 66 and 68 through 70 with 35 U.S.C. § 112, second paragraph.

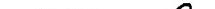
We remand this application to the examiner to consider the issues that we have raised above with respect to the compliance of appealed claims 60 through 66 and 68 through 70 with 35 U.S.C. § 112, second paragraph.

The examiner's decision is reversed.

Reversed and Remanded

Frank R.

CHUNG K. PAK
Administrative Patent Judge



CHARLES F. WARREN
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

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